

IN THE DRAWINGS

AMENDMENTS TO THE DRAWINGS

The figures have been amended to address the Examiner's objection by coupling elements as described in the specification. A full set of replacement drawings are included with this response. No new matter has been introduced.

REMARKS

Claims 9-16, 24-30 and 35-38 were examined. All claims were rejected. In response to the above-identified Office Action, Applicants amend claims 9 and 24, but do not cancel any claims or add any new claims. Reconsideration of the rejected claims in light of the aforementioned amendments and the following remarks is requested.

I. Claims Rejected Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 9-16 and 24-30 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention. The objectionable phrase, found in independent claims 9 and 24, is “without any action required from any user of the plurality of computers.” Applicants have replaced this phrase with the more concise term “automatically.” Withdrawal of this rejection is respectfully requested.

II. Claims Rejected Under 35 U.S.C. § 101

The Examiner rejected claims 37 and 38 under 35 U.S.C. § 101 on the ground that they are allegedly directed to non-statutory subject matter (specifically, “to an abstract idea in which a concrete, useful tangible result does not occur.”) Claim 37 recites (and claim 38 refines) a system comprising several concrete elements: three computers, a database and a report preparation server. Furthermore, the claim elements recite operations that the computers are to perform and information that the database is to store. Applicants are unsure what basis the Examiner has for considering these things to be “abstract ideas.”

The Examiner also alleges that “the claim does not recite a functional tangible result for each cited structure.” Applicants are unaware of any requirement that such a result be recited in a system claim, but in any case, the

structures of claim 37 interact to cause the database to store a copy of a download request (a result that is, in fact, recited in the claim), and the additional structures of claim 38 interact to prepare a report based on information in the database (also recited). Both of these are believed to be functional tangible results.

Applicants respectfully request that these rejections of claims 37 and 38 be withdrawn. Alternatively, additional details of the Examiner's reasoning are requested to help Applicants understand and respond to these rejections.

III. Claims Rejected Under 35 U.S.C. § 102(e)

The Examiner rejected claims 35 and 37 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0028610 by Pearson ("*Pearson*"). *Pearson* describes a peer-to-peer file sharing system that transmits data using user datagram protocol ("UDP") packets.

Claim 35 recites a method comprising several operations, including obtaining, from each of a plurality of computers, a list of files shared that computer; and storing the obtained plurality of lists of shared files in a database. *Pearson* is mostly concerned with lists of *computers* that share a *single file* (see, e.g., [0008]: "host computer may be programmed to generate from the plurality of other host computers a list of *other host computers* where a *user-selected file* is stored" (emphasis added)). A list of computers that have a file is different from a plurality of lists of files shared by a plurality of computers.

Furthermore, *Pearson* does not store lists of files in a database. Instead, it "maintains a database or registry of those files for which 'permission to share' is required." (See *Pearson* [0045].) Even if *Pearson*'s database or registry is considered to be a "list of files," it is not a *plurality* of lists of files, and it is not obtained by requesting lists of shared files from a plurality of computers. (Instead, it is generated by the process shown in *Pearson*'s Figure 7, which does not involve any request for a list of files shared by a computer.)

For at least the foregoing reasons, Applicants respectfully submit that claim 35 is not anticipated by *Pearson* and request that this rejection be withdrawn.

Claim 37 recites a system comprising several elements, including a monitor computer coupled to a network to block a download request from a query computer. The Examiner's analysis aligns a step in *Pearson*'s method of Figure 5 and some text describing *Pearson*'s method of Figure 3 with the claimed monitor computer. Although both of *Pearson*'s methods can probably be carried out by a computer, they are not themselves computers, and in any case, neither method blocks a download request from a query computer, as the claim requires. Applicants note that *Pearson* uses the word "block" frequently in the cited paragraph [0029], but the meaning there refers to the rectangular boxes in the flow chart, not to the act of stopping, intercepting, hindering or barring a download request from a query computer. Furthermore, as noted above, *Pearson*'s database contains files for which "permission to share" is required, not copies of blocked download requests.

For at least these reasons, Applicants respectfully submit that claim 37 is not anticipated by *Pearson* and request that this rejection be withdrawn.

IV. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 15, 16 and 24-28 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application No. 2002/0138471 by Dutta *et al.* ("*Dutta*") in view of U.S. Patent Application No. 2004/0193900 by Nair ("*Nair*").

Claim 9 recites a system for tracking file storage on a file-sharing or peer-to-peer network comprising several elements, including a transfer device adapted to passively transfer a list of shared files from each computer of a plurality of computers and automatically store the list of shared files in a database. The portion of *Dutta* that allegedly reads on this limitation actually monitors the *usage* of search result files and rates the files based on their usage.

And, although it is not discussed in sections explicitly cited by the Examiner, it appears that *Dutta* stores *search keywords and peer node identifiers* in a database, not the lists of shared files (see, e.g., *Dutta* [0071]). This is consistent with *Dutta*'s purpose of identifying peer nodes that have "good" content for particular searches, in the sense that search results from those peer nodes are often downloaded and used. However, search keywords and peer node identifiers are different from lists of shared files.

The Examiner asserts that *Dutta* fails to teach passive transfer. This is true, as far as it goes: in *Dutta* [0060], it is explicitly stated that "*the user* of the peer node retrieves and uses the files." Of course, the search result post-processor seems to be monitoring passively as the user does the retrieving, but again, the post processor is collecting different information (not lists of shared files, as claimed). The Examiner relies on *Nair* [0009] for the "passively" and "automatically" features of claim 9. Applicants are unable to discern any relevant material in that paragraph, but even assuming (solely for the sake of argument) that *Nair* does teach automatic and passive operations, and that it could be combined with *Dutta*, the references together still fail to teach or suggest at least the elements of passively transferring lists of shared files and automatically storing the lists in a database.

For at least the foregoing reasons, Applicants respectfully submit that claim 9 is patentable over the references of record, and request that the Examiner withdraw this rejection.

Claims 10-12, 15 and 16 depend directly or indirectly on claim 9, and are also believed to be patentable for at least the reasons discussed above. The Examiner is respectfully requested to withdraw these rejections as well.

Claim 24 recites a method of tracking file storage on a file-sharing or peer-to-peer network comprising several steps, including passively transferring a listing of a plurality of shared files from each of a plurality of computers connected to a network, and automatically storing the listing in a database. The

Examiner observes that *Dutta* does not explicitly teach passively transferring a listing. This is correct: as Applicants point out above, *Dutta* explicitly teaches *actively* transferring a *file*. This is at least two steps removed from the claim element: it is not done passively, and it is not transferring the claimed information. Thus, even if *Nair* [0009] taught or suggested what is attributed to it by the Examiner, the combined references simply do not describe an identical or even particularly similar method. For at least these reasons, Applicants respectfully request that the rejection of claim 24 be withdrawn.

Claims 25-28 depend directly or indirectly on claim 24, and are believed to be patentable for at least the reasons discussed above. The Examiner is respectfully requested to withdraw these rejections.

The Examiner rejected claims 13, 14, 29 and 30 under 35 U.S.C. § 103(a) as unpatentable over *Dutta* (*supra*) in view of *Nair* (*supra*) and further in view of U.S. Patent Application No. 2003/0105831 by O'Kane ("*O'Kane*"). These claims depend directly or indirectly on claim 9 or claim 24, which were discussed above. The Examiner relies on *O'Kane* only for its alleged teaching of a report preparation server. Applicants have been unable to locate a report preparation server in the cited sections or in the reference more generally, but even assuming (solely for the sake of argument) that *O'Kane* does contain that material, and that it could be combined with *Dutta* and *Nair*, the three references together still fail to teach or suggest the elements of base claims 9 and 24, as discussed above.

The Examiner rejected claims 36 and 38 under 35 U.S.C. § 103(a) as unpatentable over *Pearson* (*supra*) in view of *O'Kane* (*supra*). These claims refine the method and system of claims 35 and 38 (respectively), adding limitations concerning report preparation. As stated above, Applicants do not find report-preparation teachings in *O'Kane*, and in any case, the supplemental reference fails to remedy the deficiencies of the primary reference with respect to base claims 35 and 37. Consequently, claims 36 and 38 are believed to be

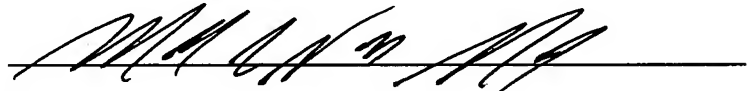
patentable over the references of record, and the Examiner is respectfully requested to withdraw these rejections.

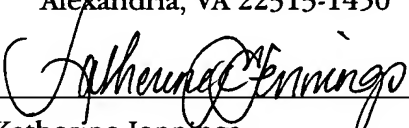
CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 9-16, 24-30 and 35-38, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Respectfully submitted,
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<p>12400 Wilshire Boulevard Seventh Floor Los Angeles, California 90025 (310) 207-3800</p>	<p style="text-align: center;"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that the correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail, in an envelope addressed to:</p> <p style="text-align: center;">Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p style="text-align: center;"> Katherine Jennings</p> <p style="text-align: right;">9-29-06 Date</p>
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